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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,019	12/03/2003	Gary L. Johnson	CPI-042CN2	8027

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EXAMINER	
DAVIS, MINH TAM B	

ART UNIT	PAPER NUMBER
1642	

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/728,019	JOHNSON, GARY L.	
	Examiner	Art Unit	
	MINH-TAM DAVIS	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-40* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Claims 1-3 are linking claims, linking groups 1-3. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 1-3. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP 804.01.

Group 1, claims 1-4, 7-8, drawn to a mouse MEKK1 protein or a fragment thereof, which MEKK1 mediates apoptosis, classified in class 530, subclass 350.

Group 2, claims 1-3, 5, 8, 39-40, drawn to a human MEKK1 protein or a fragment thereof, which MEKK1 mediates apoptosis, or has kinase activity, classified in class 530, subclass 350.

Group 3, claims 1-3, 6, 8, drawn to a rat MEKK1 protein or a fragment thereof, which MEKK1 mediates apoptosis, classified in class 530, subclass 350.

Claim 9 is a linking claim, linking groups 4-6. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 9. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP 804.01.

Group 4, claims 9-14, drawn to a variant mouse MEKK1 protein or a fragment thereof, having substitutions, such that the MEKK1 is resistant to proteolysis, classified in class 530, subclass 350.

Group 5, claims 9-13, 15, drawn to a variant human MEKK1 protein or a fragment thereof, having substitutions, such that the MEKK1 is resistant to proteolysis, classified in class 530, subclass 350.

Group 6, claims 9-13, 16, drawn to a variant rat MEKK1 protein or a fragment thereof, having substitutions, such that the MEKK1 is resistant to proteolysis, classified in class 530, subclass 350.

Claims 17-19 are linking claims, linking groups 7-9. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 17-19. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall

be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP 804.01.

Group 7, claims 17-20, 23-24, 31, 33, drawn to a nucleic acid encoding a mouse MEKK1 protein or a fragment thereof, which MEKK1 mediates apoptosis, classified in class 530, subclass 23.1.

Group 8, claims 17-19, 21, 23-24, 31, 33, drawn to a nucleic acid encoding a human MEKK1 protein or a fragment thereof, which MEKK1 mediates apoptosis, or has kinase activity, classified in class 530, subclass 23.1.

Group 9, claims 17-19, 22-24, 31, 33, drawn to a nucleic acid encoding a rat MEKK1 protein or a fragment thereof, which MEKK1 mediates apoptosis, classified in class 530, subclass 23.1.

Claim 25 is a linking claim, linking groups 10-12. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 25. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the

allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP 804.01.

Group 10, claims 25-28, 32, 34, drawn to a nucleic acid encoding a variant mouse MEKK1 protein or a fragment thereof, having substitutions, such that the MEKK1 is resistant to proteolysis, classified in class 530, subclass 23.1.

Group 11, claims 25-27, 29, 32, 34, drawn to a nucleic acid encoding a variant human MEKK1 protein or a fragment thereof, having substitutions, such that the MEKK1 is resistant to proteolysis, classified in class 530, subclass 23.1.

Group12, claims 25-27, 30, 32, 34, drawn to a nucleic acid encoding a variant rat MEKK1 protein or a fragment thereof, having substitutions, such that the MEKK1 is resistant to proteolysis, classified in class 530, subclass 23.1.

Claim 35 is a linking claim, linking groups 13-15. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 35. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a

restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP 804.01.

Group 13, claim 35, drawn to a method for stimulating apoptosis, using an expressing vector encoding a mouse MEKK1 active fragment, classified in class 514, subclass 44.

Group 14, claim 35, drawn to a method for stimulating apoptosis, using an expressing vector encoding a human MEKK1 active fragment, classified in class 514, subclass 44.

Group 15, claim 35, drawn to a method for stimulating apoptosis, using an expressing vector encoding a rat MEKK1 active fragment, classified in class 514, subclass 44.

Claim 36 is a linking claim, linking groups 16-18. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 36. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP 804.01.

Group 16, claim 36, drawn to a method for inhibiting apoptosis, using an expressing vector encoding a mouse protease-resistant MEKK1 protein, classified in class 514, subclass 44.

Group 17, claim 36, drawn to a method for inhibiting apoptosis, using an expressing vector encoding a human protease-resistant MEKK1 protein, classified in class 514, subclass 44.

Group 18, claim 36, drawn to a method for inhibiting apoptosis, using an expressing vector encoding a rat protease-resistant MEKK1 protein, classified in class 514, subclass 44.

Claim 37 is a linking claim, linking groups 19-21. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 37 . Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP 804.01.

Group 19, claim 37, drawn to a method for generating a mouse MEKK1 active fragment, classified in class 435, subclass 7.1.

Group 20, claim 37, drawn to a method for generating a human MEKK1 active fragment, classified in class 435, subclass 7.1.

Group 21, claim 37, drawn to a method for generating a rat MEKK1 active fragment, classified in class 435, subclass 7.1.

Claim 38 is a linking claim, linking groups 22-24. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 38. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP 804.01.

Group 22, claim 38, drawn to a method for identifying a compound that modulates the apoptotic activity of a mouse active MEKK1 fragment, classified in class 435, subclass 7.1.

Group 23, claim 38, drawn to a method for identifying a compound that modulates the apoptotic activity of a human active MEKK1 fragment, classified in class 435, subclass 7.1

Group 24, claim 38, drawn to a method for identifying a compound that modulates the apoptotic activity of a rat active MEKK1 fragment, classified in class 435, subclass 7.1.

This application contains claims directed to the following patentably distinct species:

For any one of groups 1-24, the species of MEKK1.1 or MEKK1.2.

The inventions are distinct, each from each other because of the following reasons:

A. Inventions (1-12) represent separate and distinct products, which are made by materially different methods, and are used in materially different methods, which have different modes of operation, different functions and different effects.

The polypeptides of groups 1-6, the polynucleotides of groups 7-12 are all structurally distinct molecules and chemically different from each other. The polynucleotide is made by nucleic acid synthesis, while the polypeptide is made by translation of mRNA. Further, the polynucleotide can be used for hybridization screening, the polypeptide can be used for methods of treatment. Furthermore, neither of the inventions is essential for the production of the other, and they have different modes of operation, different functions, and different effects. While a polypeptide can made by methods using the corresponding polynucleotide, it can also be recovered from a natural source using biochemical means. For instant, the polypeptide can be isolated, using affinity chromatography.

Further, it is noted that for unity of invention, the compounds have to (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential for that utility. *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and Ex parte Hozumi, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). In the instant application, although the different sequences could be used for stimulating or inhibiting apoptosis, however, the sequences for use in the claimed methods are distinct, because they do not share a substantial structure feature disclosed as being essential for stimulating or inhibiting apoptosis.

Searching all the polypeptides of groups 1-6, and the polynucleotides of groups 7-12 would cause serious burden. In the instant case, the search of all the polynucleotides, and the

polypeptides are not coextensive. Prior to the concomitant isolation and expression of the sequence of interest there may be journal articles devoted solely to one polynucleotide which would not have described other polynucleotides, or the polypeptide. Similarly, there may be journal articles devoted solely to the polypeptide, which would not have described the polynucleotide.

As such, it would be burdensome to search the inventions of Groups 1-12 together.

B. The inventions of Groups 13-24 are materially distinct methods. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, and different effects (MPEP § 806.04, MPEP § 808.01). The instant specification does not disclose that these methods would be used together. The inventions of Groups 13-24 are materially distinct methods, which differ at least in objectives, method steps, reagents and/or dosages and/or schedules used, response variables, and criteria for success. Further, the method of stimulating or inhibiting apoptosis, using a polynucleotide, a method of making an active MEKK1 fragment, a method for identifying compounds that modulate apoptotic activity are all unrelated as they have different modes of operation, and differ in method steps and reagents used. For increasing or inhibiting apoptosis, a MEKK1 polynucleotide is administered to a patient having diseases, using any mode of administration. For making an active fragment of MEKK1, a caspase protease may be used. For identifying a compound that modulates the apoptotic activity, a detection of the apoptotic activity may be used. Thus, each group is unrelated as they comprise distinct steps and utilize different products, which demonstrates that each method has different mode of operation. Moreover, different products used in the different methods, which are distinct because they are different

polynucleotides or polypeptides with distinct structure and function, would produce different effects. For these reasons the Inventions 13-24 are patentably distinct.

Furthermore, the distinct steps and products require separate and distinct searches. The examination of all groups would require different searches in the U.S. patent shoes and the scientific literature and would require the consideration of different patentability issues. There may be journal articles devoted solely to a method for inhibiting apoptosis, which would not have described methods of increasing apoptosis, or a method for making an active fragment of MEKK1, or a method for identifying a compound that modulates apoptotic activity, or vice versa.

As such, it would be burdensome to search the inventions of Groups 13-24 together.

C. Invention of groups 1-3 and 19-21 are related as product made and process of making. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another materially different product or (2) that the product as claimed can be made by another materially different process (MPEP § 806.05(f)). In the instant case, the MEKK1 active fragment could be made by recombinant method, rather than by an enzymatic process, using caspase protease.

D. Inventions of groups 1-3 and 22-24 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05 (h). In this instant case, a polypeptide could be used for several

purposes, e.g. for biochemical assay, for making antibodies, and for making an affinity column to purify its antibodies.

Searching the inventions of Groups (1-3) and Groups (22-24) together would impose serious search burden. The inventions of Groups (1-3) and Groups (22-24) have a separate status in the art as shown by their different classifications. Moreover, in the instant case, the searches for the polypeptide and the method of identifying a compound that modulates apoptotic activity, using the polypeptide are not coextensive. The search for Groups (22-24) would require a text search for the method of of identifying a compound that modulates apoptotic activity, in addition to a search for the polypeptide. Moreover, even if the polypeptide product were known, the method of of identifying a compound that modulates apoptotic activity, which uses the product may be novel and unobvious, in view of the preamble or active steps.

E. Inventions of groups 7-9 and 13-15 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05 (h). In the instant case, a DNA sequence could be used for the detection of similar DNA or RNA sequences, for making an expression vector, and for producing its encoded protein.

Searching the inventions of Groups (7-9) and Groups (13-15) together would impose serious search burden. The inventions of Groups (7-9) and Groups (13-15) have a separate status in the art as shown by their different classifications. Moreover, in the instant case, the search for the polynucleotide and the method of increasing apoptosis using the polynucleotide are not

coextensive. The search for Groups (13-15) would require a text search for the method of increasing apoptosis, in addition to a search for the polynucleotide sequence of groups (7-9). Moreover, even if the polynucleotide product were known, the method of increasing apoptosis, which uses the product may be novel and unobvious, in view of the preamble or active steps.

F. Inventions of groups 10-12 and 16-18 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05 (h). In the instant case, a DNA sequence could be used for the detection of similar DNA or RNA sequences, for making an expression vector, and for producing its encoded protein.

Searching the inventions of Groups (10-12) and Groups (16-18) together would impose serious search burden. The inventions of Groups (101-2) and Groups (16-18) have a separate status in the art as shown by their different classifications. Moreover, in the instant case, the search for the polynucleotide and the method of inhibiting apoptosis using the polynucleotide are not coextensive. The search for Groups (16-18) would require a text search for the method of inhibiting apoptosis, in addition to a search for the polynucleotide sequence of groups (10-12). Moreover, even if the polynucleotide product were known, the method of inhibiting apoptosis, which uses the product may be novel and unobvious, in view of the preamble or active steps.

G. Inventions of groups 1-6 are unrelated to the methods of the inventions of groups 13-18, because the product of groups (1-6) is not used or otherwise involved in the processes of groups 13-18.

Inventions of groups 7-12 are unrelated to the methods of the inventions of groups 19-21, 22-24, because the product of groups (7-12) is not used or otherwise involved in the processes of groups 19-21, 22-24.

The species are distinct, because they are different polypeptides or polynucleotides, having different structure. It is noted that for unity of invention, the compounds have to (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential for that utility. *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and Ex parte Hozumi, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). In the instant application, although the different sequences could be used for stimulating or inhibiting apoptosis, however, the sequences for use in the claimed methods are distinct, because they do not share a substantial structure feature disclosed as being essential for stimulating or inhibiting apoptosis.

Because these inventions are distinct for the reason given above and have acquired a separate status in the art, and because the searches for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

Applicants are required under 35 USC 121 to elect a single disclosed group for prosecution on the merits to which the claims shall be restricted.

Applicant is also required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so**

may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 571-272-0830. The examiner can normally be reached on 9:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY SIEW can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MINH TAM DAVIS
September 27, 2006

JEFFREY SIEW
SUPERVISORY PATENT EXAMINER